

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN L. BAUGH,  
ROD BENNETT  
and GEORGE GIVENS

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Appeal No. 2002-1837  
Application 09/315,411

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ON BRIEF

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Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John L. Baugh et al. appeal from the final rejection (Paper No. 12) of claims 14 and 15. Claims 1 through 6 and 13 stand allowed. Claims 7 through 12 and 16 through 28, the only other claims pending in the application, stand withdrawn from consideration as not being readable on the elected species of the appellants' invention.

### THE INVENTION

The invention relates to a method of completing a wellbore. Claims 14 and 15, as well as their parent claims 1 and 13, read as follows:

1. A method of completing a well, comprising:  
running in a tubular string into a cased borehole;  
expanding a portion of said tubular into supporting contact with the casing;  
delivering a sealing material through at least one opening in said tubular, with said tubular so supported;  
closing off said opening.

13. The method of claim 1, further comprising:  
using full circumferential contact for said supporting contact.

14. The method of claim 13, further comprising:  
providing a valve with said opening;  
operating said valve to close off said opening.

15. The method of claim 14, further comprising:  
providing a sliding sleeve on said tubular string as said valve.

### THE REJECTION

Claims 14 and 15 stand rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (final rejection, page 2).

Attention is directed to the appellants' main and reply briefs (Paper Nos. 18 and 20) and to the examiner's final rejection and answer (Paper Nos. 12 and 19) for respective positions of the appellants and the examiner regarding the merits of this rejection.<sup>1</sup>

### DISCUSSION

#### I. Preliminary matter

The appellants in their main brief (see pages 1, 2, 7 and 8) raise as an issue in the appeal the examiner's withdrawal of claims 7, 12 and 21 from consideration as not being readable on the elected species of the invention, and then in their reply brief (see page 1) state that this issue has been rendered moot by the filing of divisional applications. Hence, we shall not further address the matter except to say that since the examiner's action in this regard was not directly connected with the merits of issues involving a rejection of claims, it would have been reviewable by petition to the Director rather than appeal to this Board. See In re Hengehold, 440 F.2d 1395, 1403-04, 169 USPQ 473, 479 (CCPA 1971); and MPEP § 821.

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<sup>1</sup> The restatement of the rejection in the examiner's answer mistakenly implies written description, rather than enablement, issues. The substantive discussions of the rejection in the final rejection and answer make clear that the rejection is based on enablement concerns.

II. The merits of the appealed rejection

The examiner considers the appellants' specification to be non-enabling with respect to the subject matter recited in claims 14 and 15 because:

[t]he specification fails to disclose how the sliding valve is moved from the open position shown in Figures 12-13 to the closed position shown in Figures 14-15. The specification discloses on page 6, lines 18-20 that "[a]t the conclusion of the cementing step, the sliding valve 48 is actuated in a known manner to close it off, as shown in Figure 14." However, conventional sliding valves have a sliding sleeve mounted within a tubing or casing. The sliding sleeve is usually moved between its open and closed positions by a shifting tool or by fluid pressure within the tubing or casing. Appellants' sliding sleeve shown in Figures 12-15 is located outside of the tubular 56. It is not clear what is the "known manner" to close the valve 48 off [answer, pages 4 and 5].

The dispositive issue with respect to the enablement requirement of § 112, ¶ 1, is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Although Figures 12 through 15 in the instant application do, as observed by the examiner, show the sliding sleeve valve 48 to be mounted on the outside of the tubular (string) 56, neither claim 14 nor claim 15 actually calls for the valve to be so mounted. For the reasons expressed by the appellants (see page 3 in the reply brief), the examiner's contention (see page 5 in the answer) that the use in claim 15 of "on" rather than --in-- requires the sleeve to be outside the tubular string stems from an unduly restrictive interpretation of the claim. Moreover, even if claims 14 and 15 did actually set forth that the valve or sliding sleeve is outside the tubular string, the examiner, in addition to acknowledging that internal valves/sliding sleeves are conventional, concedes (see pages 5 and 6 in the answer) in the face of the appellants' citation of U.S. Patent No. 4,602,684 (see pages 3 through 5 in the main brief) that external valves/sliding sleeves also are known. Given these admissions as to the scope of the prior art, the examiner has not cogently explained, nor is it apparent, why the appellants' disclosure would not have enabled a person of ordinary skill in the art to make and use the invention set forth in claims 14 and 15 without undue experimentation, even if these claims required the valve/sliding sleeve to be outside the tubular string. The

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examiner's additional rationalization (see pages 6 and 7 in the answer) that the appellants' swage assembly 52, which is disclosed as performing the "expanding" step recited in parent claim 1, could interfere with the sliding sleeve valve 48 is purely conjectural, and is ostensibly belied by the disclosed spaced relationship between these two elements (see Figures 12 through 15 and page 6 in the specification).

In light of the foregoing, the examiner's position that the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would not have enabled a person of such skill to make and use the invention recited in claims 14 and 15 without undue experimentation is not well founded. Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of these claims.

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SUMMARY

The decision of the examiner to reject claims 14 and 15 is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
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	)	APPEALS AND
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	INTERFERENCES
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JOHN P. MCQUADE	)	
Administrative Patent Judge	)	

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